

REMARKS

Claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 are rejected as being obvious over Motoyama in view of Hanson.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on applicant's disclosure. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious unless the prior art suggests the desirability of the modification. Motoyama and Hanson fail to suggest any motivation for, or desirability of, the changes espoused. Here, hindsight is relied upon to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Hindsight reconstruction cannot be used to pick and choose elements among isolated disclosures in the prior art to deprecate the claimed invention.

The Examiner states "Since both references are in the same general field of endeavor, namely digital document data processing" and that it would have been obvious "to perform the steps of receiving, assigning, and instructing, as taught by Motoyama, using a GUI and thus creating an amended document, as taught by Hanson. The motivation for doing so would have been to allow a user to modify the contents of the document and the manner in which said document is printed."

It is respectfully submitted that this does not amount to a proper teaching or suggestion in the prior art and that the references have been brought together through the use of an impermissible amount of hindsight and the teaching of the present invention, and not the references themselves. Applicant's submit the references are not in the same field of endeavor. Motoyama teaches a document processing system that controls the printing of documents represented in page description language. Hanson is directed to a an object-oriented HTML based editor for creating Web documents to be published on the World Wide Web. Motoyama and Hanson themselves teach the respective uses of their

respective arrangements for their respective purposes. The mere fact that they could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. Motoyama and Hanson fail to suggest any motivation for, or desirability of, the changes espoused.

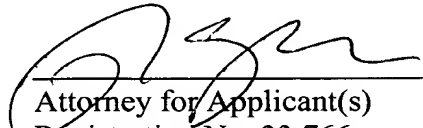
Also, the only rationale provided by the Examiner for combining the references consists of a listing of advantages that would result after the combination, but does not include any showing of where the advantages are disclosed in any of the cited references. Using advantages only found in Applicant's disclosure against Applicant is impermissible hindsight that cannot serve as motivation to combine the references. The references themselves teach the respective uses of their respective arrangements for their respective purposes. The mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

Also, in order to establish a prima facie case of obviousness, the prior art references must teach or suggest all the claim limitations. While applicant's take issue with the proposed combination, even if a person of ordinary skill in the art would find it obvious to combine the teachings of Motoyama and Hanson as suggested, the claimed features still would not be met. Specifically, it is respectfully submitted that neither Motoyama and Hanson either singularly or in combination, disclose or suggest a system which permits a **print operator to assign group identifiers into the document** to establish **groups of pages** in the document to thereby create an amended document to send one or more of the groups of pages **for printing**.

As the Applicant's have demonstrated, a combination of Motoyama and Hanson is not obvious because of the lack of motivation in either of these references to make the combination and the additional new object accomplished

by the combination which is not suggested in either of the references. Claims which further depend on this combination are therefore not obvious.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 33,766

Richard A. Romanchik/d-n
Rochester, NY 14650
Telephone: 585-726-7522
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.